



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO.
			EXAMINER
		ART UNIT	PAPER NUMBER

7

DATE MAILED:

This is a communication from the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s) ~~or~~ thirty days, ~~whichever is longer~~, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-31 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

Art Unit: 1652

### **DETAILED ACTION**

1. The Group and/or Art unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1652.

#### ***Restriction Requirement***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-22, drawn to methods of producing biotin vitamers comprising bacteria expressing a lysine-utilizing DAPA aminotransferase, classified in class 435, subclass 120.
  - II. Claims 23-28, drawn to bacteria overproducing a lysine-utilizing DAPA aminotransferase and a SAM-utilizing DAPA aminotransferase, classified in class 435, subclass 252.31.
  - III. Claims 29-31, drawn to biotin vitamers, classified in class 548, subclass 303.7.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are patentably distinct from each other. The methods of Group I and the bacteria of Group II do not require each other for their practice; have separate utilities, such as use of the Group I methods to produce biotin vitamers versus use of the Group II bacteria to

Art Unit: 1652

produce aminotransferases for use in non-biotin related *in vitro* reactions; and are subject to separate manufacture and sale. The Groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

4. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product, or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the biotin vitamers of Group III can be made by a process materially different from the methods of Group I, such as purification from naturally occurring sources.

5. Inventions II and III are patentably distinct from each other. The bacteria of Group II and the biotin vitamers of Group III do not require each other for their practice; have separate utilities, such as use of the Group II bacteria to produce aminotransferases for use in non-biotin related *in vitro* reactions versus use of the biotin vitamers as substrates; and are subject to separate manufacture and sale. The Groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

6. Because these inventions are distinct for the reasons given above; have acquired a separate status in the art as shown by their different classification; and the search required for any one of

Art Unit: 1652

the Groups is not required for any other, restriction for examination purposes as indicated is proper.

7. A telephone call was made to John W. Freeman on September 11, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications should be directed to Kawai Lau whose telephone number is 703-308-4209. The examiner can normally be reached Monday-Friday from 7 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax, can be reached at 703-308-4216. The fax phone number for Official

Serial Number: 08/914,332

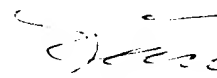
Page 5

Art Unit: 1652

Papers to Technology Center 1600 is (703) 305-3014 or (703) 308-4242. The fax phone number for Unofficial Papers to the Examiner is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is 703-308-0196.

Kawai Lau, Ph.D.  
Group 1650  
September 15, 1998



**Kawai Lau**

**Patent Examiner**

**Technology Center 1600**